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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,244	11/28/2001	Daniel Richard Schaefer	594826-001	3771

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EXAMINER

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

1. The Substitute Appeal Brief filed 10/8/04 is not fully responsive to the prior Office action dated 9/8/04 for the following reasons.

The first brief filed 5/14/04 was held defective for several reasons in the 9/8/04 Office action.

Four of those reasons still have not been properly corrected in the 10/8/04 brief.

The first of these reasons concerns the status of all claims pending or cancelled and, the identity of the appealed claims. The 10/8/04 brief still does not properly identify the appealed claims as it improperly lists withdrawn claims 30-32 as among the appealed claims.

The second of these issues concerns the Summary of the invention.

While the 10/8/04 brief has removed the word "verified" from the Summary of the invention, the Summary still includes the statement:

"This emission indicates that a thermal neutron is present and the only place this neutron could exist is in the fullerene cage."

The specification itself does not actually make this "factual" statement. Instead, the specification sets forth appellants conclusion (based on other conclusions) and, this conclusion of appellants cannot be taken out of context without destroying its original meaning.

The examiner had included in the 9/8/04 Office action, a copy of the actual paragraph in question, from appellants specification. This paragraph (from page 9 of the specification) is again reproduced below.

"Evidence that neutrons are trapped in the fullerene molecule consists of the presence of a pure beta emitter in the fullerene that remains after the counts

resulting from the gamma emitters have been stripped from the raw data. The pure beta emitter has a half life of about ten minutes. There are very few pure beta particle emitters with a half life anywhere near ten minutes. The rarity of these pure beta emitters, their chemical nature, and the chemical nature of the fullerene all point to the conclusion that they cannot be the source of the pure beta emitter observed in the irradiated fullerene. The only other possible source of the radiation is the decay of free neutrons." (Underlining added).

The third of these four reasons is that the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together in regard to the issue under 35 U.S.C. 112, second paragraph, yet does not present arguments in support thereof in the argument section of the brief. The 10/8/04 brief still does not comply with this requirement because the arguments on pages 8 and 9 thereof only recite what each claim covers.

Even 37 CFR 1.192 (c)(7) itself states in regard to the "Grouping of claims".

Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

The fourth of these reasons concerns the presentation and discussion in the brief, of new evidence.

Page 3 of the 9/8/04 Office action gave as an example of this new evidence, the presentation on page 8 of the 5/14/04 brief.

Said page 8 of the 5/14/04 brief presented (among other things) a table (Table I) which set forth information from 4 experiments.

While the 10/8/04 brief has deleted said Table I, it has not deleted all references to said Table I nor has it deleted all of the newly presented evidence.

Again, for example, the paragraph immediately preceding said Table I in the 5/14/04 brief (spanning pages 7 and 8 thereof) contains references to "repetitive sample experiments", testing of "irradiated fullerene samples", etc., all of which clearly refer to the Table I which immediately follows it.

However, while applicant has deleted said Table I from the 10/8/04 brief, the said paragraph spanning pages 7 and 8 of the 5/14/04 brief (which contained references to the experiments and irradiated fullerene samples in said Table I), has been reproduced in its entirety on page 7 of the 10/8/04 brief (and thus the 10/8/04 brief still contains references to said new evidence).

As a further example, the first and second paragraphs immediately following said Table I on page 8 of the 5/14/04 brief also contained references to the irradiated fullerene samples of said Table I.

While the 10/8/04 brief has deleted the first of said two paragraphs which immediately followed said Table I of the 5/14/04 brief, the second of said two paragraphs (with its references to the irradiated fullerene samples of said (now deleted) Table I) has again been reproduce in its entirety as the paragraph bridging pages 7 and 8 of the 10/8/04 brief.

On page 6 of the 10/8/04 brief, lines 1-7 (in regard to the evidence concerning graphite) and the second full paragraph still represent new evidence. Said second full paragraph has been reproduced in its entirety from the paragraph bridging page 6 and 7 of the 5/14/04 brief and it still refers to the (now non-existent) Table I, and, it also refers to "recently tested samples" wherein the only activated contaminate was argon-41 and it

states that the source of the samples in the (now non-existent) Table I was a company in Arizona (all of which is new evidence). It is noted that appellants specification does not itself refer to this company in Arizona which was the source for their samples in (now non-existent) Table I. Instead, the specification on page 4 refers to a company, SES Inc. in Houston, TX, as the source of commercially available fullerenes.

As previously pointed out in said 9/8/04 Office action, any new evidence must be submitted in a paper separate from the appeal brief (MEPP 1207), and, entry of new evidence in an application on appeal is not a matter of right (MPEP 1207), and, is governed by 37 CFR 1.195 (which states that such evidence will not be admitted without a showing of good and sufficient reasons why they were not earlier presented).

If applicant still wishes to have the new evidence considered by the Office, such could be accomplished by the appropriate filing of a new application or an RCE.

2. Since the period for reply set forth in the prior Office action of 9/8/04 has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).


The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in the last Office action (9/8/04). A fully responsive reply must be timely filed to avoid abandonment of this application.

Art Unit: 3641

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'H. Behrend', with a stylized flourish at the end.

HARVEY E. BEHREND
PRIMARY EXAMINER

Behrend/vs
December 22, 2004